



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,713	07/06/2004	Johannes J. Meerman	119567	7197
25944 7590 12/29/2008 OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850				
EXAMINER				
WOLLSCHLAGER, JEFFREY MICHAEL				
ART UNIT		PAPER NUMBER		
1791				
MAIL DATE		DELIVERY MODE		
12/29/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/500,713

Applicant(s)

MEERMAN ET AL.

Examiner

JEFFREY WOLLSCHLAGER

Art Unit

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 April 2007 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CI/CD)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Response to Amendment

Applicant's amendment and the rule 1.132 declaration filed October 30, 2008 have been entered. Claims 1-7 are pending and under examination.

Drawings

The amendment to the drawings filed April 30, 2007 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Figure 2 has been modified to show the plates and the slot or diaphragm at the bottom of the coagulation bath. This objection may be overcome by pointing to the location in the original disclosure where support for this amendment may be found. Otherwise, applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Regarding claims 1 and 2, the limitation "wherein the slot or diaphragm is

Art Unit: 1791

positioned at the bottom of the coagulation bath", as shown in replacement Figure 2 filed April 30, 2007, does not appear to be supported by the original disclosure. Claims 3-7 are rejected as dependent claims. This rejection may be overcome by pointing to the location in the original disclosure where support for this limitation may be found.

Response to Arguments

Applicant's arguments and the rule 1.132 declaration filed October 30, 2008 have been fully considered, but they are not persuasive. As an initial matter, the examiner provides the following pertinent citations from MPEP 2163 which provide the basis for the 35 USC 112 written description analysis:

For the written description requirement, an applicant's specification must reasonably convey to those skilled in the art that the applicant was in possession of the claimed invention as of the date of invention.

The examiner has the initial burden of presenting evidence or reasoning to explain why persons skilled in the art would not recognize in the original disclosure a description of the invention defined by the claims. See *Wertheim*, 541 F.2d at 263, 191 USPQ at 97 ("[T]he PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims."). However, when filing an amendment an applicant should show support in the original disclosure for new or amended claims.

To comply with the written description requirement of 35 U.S.C. 112, para. 1, or to be entitled to an earlier priority date or filing date under 35 U.S.C. 119, 120, or 365(c), each claim limitation must be expressly, implicitly, or inherently supported in the originally filed disclosure. When an explicit limitation in a claim "is not present in the written description whose benefit is sought it must be shown that a person of ordinary skill would have understood, at the time the patent application was filed, that the description requires that limitation." *Hyatt v. Boone*, 146 F.3d 1348, 1353, 47 USPQ2d 1128, 1131 (Fed. Cir. 1998). See also *In re Wright*, 866 F.2d 422, 425, 9 USPQ2d 1649, 1651 (Fed. Cir. 1989)

"To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be

Art Unit: 1791

established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.”)

An objective standard for determining compliance with the written description requirement is, “does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed.” In re Gosteli, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Under Vas- Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir.1991)

Applicant's arguments and the rule 1.132 declaration initially attempt to explain why the examiner's previous response to arguments in the July 15, 2008 non-final office action does not definitively prove that the slot or diaphragm is not at the bottom of the coagulation bath. This argument is not persuasive. While the examiner understands applicant's remarks and can even agree that applicant's explanation of the citations provided by the examiner could be considered plausible (although not necessarily more plausible than the examiner's original analysis), the examiner notes that the extent of the arguments merely show that the examiner has not established beyond all uncertainty that the slot or diaphragm is not at the bottom of the coagulation bath. However, the examiner submits this argument does not rise to the level of showing that the slot or diaphragm is at the bottom of the coagulation bath. As this is what must be effectively demonstrated to overcome the rejection, the rejection is maintained.

The examiner submits that the original disclosure does not expressly disclose the argued limitation. As such, applicant is relying upon an implicit or inherent disclosure of the limitation. As set forth above, and in previous office actions, the examiner submits that citations have been provided from the original disclosure that imply/suggest the slot or diaphragm is not at the bottom of the coagulation bath. While applicant has provided a response to these citations and has provided additional citations throughout prosecution, these do not suggest the argued limitation to the extent required to demonstrate possession of the claimed invention at the time of filing.

Turning to page 5 of the 1.132 declaration, which summarizes the response to the citations provided by the examiner, it was declared that:

"Thus, since each spinning field must be paired with one slot or diaphragm (paragraph [0029]), and since each spinning field must have the same or a similar shape as the corresponding opening provided at the bottom of the coagulation bath (paragraph [0018]), it follows that paragraph [0018] unambiguously discloses the slot or diaphragm is provided at the bottom of the coagulation bath. Thus, in my opinion, new Figure 2 is supported by the disclosure in the specification."

For the sake of argument, even if the examiner conceded that each spinning field is paired with a slot or diaphragm and that each spinning field has the same or similar shape as the corresponding opening at the bottom of the coagulation bath, it is unclear to the examiner how these two facts together result in an unambiguous conclusion that the slot or diaphragm is at the bottom of the coagulation bath. It appears to the examiner that such an unambiguous conclusion must have been reached in some combination with the following statement from page 5 of the declaration:

"...if the diaphragm is not positioned at the bottom of the coagulation bath, then serious turbulence would occur between the diaphragm and the opening in the coagulation bath, which would make transport of the fiber from the diaphragm to the bath opening impossible."

However, the examiner submits there is no evidence/data on the record to support the assertion that if the diaphragm or slot is located anywhere else but the bottom of the coagulation bath it would be impossible to transport the fiber from the diaphragm or slot to the bath opening. Finally, the examiner submits that should such evidence/data be submitted it would likely require further consideration.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEFFREY WOLLSCHLAGER whose telephone number is (571)272-8937. The examiner can normally be reached on Monday - Thursday 6:45 - 4:15, alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on 571-272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1791

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. W./

Examiner, Art Unit 1791

December 29, 2008

/Monica A Huson/

Primary Examiner, Art Unit 1791